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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,845	11/30/2001	Carol Ivash Gabele	AUS920010961US1	4651

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EXAMINER

GEBRESILASSIE, KIBROM K

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/997,845

Applicant(s)

GABELE ET AL.

Examiner

Kibrom K. Gebresilassie

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the application filed November 30, 2001.
2. Claims 1-18 are examined.

### ***Oath/Declaration***

3. The office acknowledges receipt of a properly signed oath/declaration filed November 30, 2001.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters 344 and 345 have both been used to designate Design Entity Proto Files. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to because Figures started from 20D to 23C are hand-sketched drawings. Therefore, some of the drawings are not clear at all. For example, Fig. 20G looks like Fig. 206.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 8, and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, and 13 of copending Application No. 09/997,458.

This is a provisional obviousness-type double patenting rejection.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Copending Claim 1	Instant Claim 1 and 2
A method for minimizing redundancy in collected harvest event testcases from a batch simulation farm which includes a harvest testcase server that collects	The method of claim 1, wherein said testcase list is maintained by a harvest testcase server which collects harvest event testcases for said simulation

simulation data for a simulation model from at least one simulation client, said method comprising:	model, said method further comprising;
executing a testcase on said simulation model within a simulation client;	
responsive to said testcase triggering a harvest event,	updating said harvest hit table from a simulation client to include a harvest event triggered by a testcase during simulation of said simulation model;
	collecting said testcase within said testcase list;
	comparing testcases identified within said testcase list to testcases identified within said harvest hit table to determine inconsistencies therebetween
	retrieving harvest event data for said harvest event that has been triggered within said simulation client
comparing said harvest event with a list of harvest events that have previously been triggered within said simulation model;	comparing said retrieved harvest event data with a list of harvest events that have previously been triggered within

	said simulation model;
responsive to determining that said harvest event has not been previously triggered within said simulation model,	responsive to determining that said harvest event has not been previously triggered within said simulation model,
delivering said testcase to said harvest testcase server.	delivering said testcase to said testcase server.

As can be seen from the table, the only difference between copending claim 1 and instant claim 2 is that copending claim 1 contains one additional limitation (i.e. executing a testcase on said simulation model within a simulation client). It would have been obvious to one of ordinary skill in the art to add the step of executing a testcase to claim 2 of the present application. This would allow the method to execute the testcases within a simulation client.

The same rationale is also applicable for the rejection of instant claims 8 and 14 as being obvious variations of copending claims 7 and 13 respectively.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. *The Examiner submits that Applicant's have not recited any limitations relating to a practical application in the technological arts and have merely claimed a manipulation of non-functional descriptive material or, at best, software per*

*se. Section 2106 [R-2] (Patentable Subject Matter - Computer-Related Inventions) of the MPEP recites the following:*

*"In practical terms, claims define nonstatutory processes if they:*  
*- consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or*  
*- simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application."*

*An invention which is eligible for patenting under 35 U.S.C. § 101 is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a **"useful, concrete and tangible result."** The test for practical application as applied by the examiner involves the determination of the following factors:*

*(1) "Useful" - The Supreme Court in Diamond v. Diehr requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.*

*(2) "Tangible" - Applying In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In Warmerdam the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium which enabled its functionality to be realized.*

*(3) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An*



*appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.*

*The Examiner respectfully submits, under current PTO practice, that the claimed invention does not recite either a useful, concrete, or tangible result and is merely drawn to a manipulation of abstract ideas.*

- *The claims are not **tangible** since, for example, claim 7 appears to be software only, and fail the tangible test. Because applicant has invoked 112, 6<sup>th</sup> paragraph, but it appears "processing means for..." are just software subroutines. Furthermore, claims 8-13 don't appear to resolve the problem, since server is connected to the system and not claimed as part of the system. As per claims 14-18, absent recitation of tangible medium, the "product" of claims 14-18 is just instructions, which is non-functional descriptive material or, at best, software per se, not tangibly embodied.*

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 5, 7, 10, 11, 13, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,195,627 issued to Bargh in view of U.S. Patent No. 6,292,909 issued to Hare.

**As per claim 1:**

Bargh discloses a method for resolving testcase (test vectors; col. 3 line 4) collection inconsistencies (discrepancies; col. 3 line 9) between a testcase list which includes testcases that have triggered harvest events (harvest event; col. 13 line 34) within a simulation model (simulation model 329; col. 7 line 64), and a harvest hit table (flags 423; col. 14 line 36) which records harvest events that have been triggered during simulation (col. 16 line 39) of said simulation model (simulation model 329; col. 7 line 64), said method comprising:

updating said harvest hit table from a simulation client (simulation programmer; col. 3 lines 30-31) to include a harvest event (harvest event; col. 13 line 34) triggered by a testcase (test vectors; col. 3 line 4) during simulation (col. 16 line 39) of said simulation model (col. 16 line 48);

collecting said testcase (test vectors; col. 3 line 4) within said testcase list; and

comparing testcases identified within said testcase list to testcases identified within said harvest hit table (flags 423; col. 14 line 36) to determine inconsistencies (discrepancies; col. 3 line 9) therebetween.

Bargh fails to disclose a testcase list, which include a testcase. However, Hare discloses a testcase list (col. 4 line 41; Fig 2 element no. 56). It would have been obvious to one of ordinary skill in the art to modify the method of Bargh to include a testcase list as taught by Hare. The motivation for doing so would have been more convenient to organize and watch which testcases within the testcase list are triggered.

**As per claim 4:**

Hare discloses a single testcase entry for each triggered harvest event (individual testcase; Fig. 2 element 58; col. 4 line 30).

**As per Claim 5:**

Hare discloses an instrumentation server (Application server; col. 3 line 1-2; Fig. 1 element 38).

**As per claims 7 and 13:**

The limitations of claims 7 and 13 have already been discussed in the rejection of claim 1. They are therefore rejected under the same rationale.

**As per claims 10 and 16:**

The limitations of claims 10 and 16 have already been discussed in the rejection of claim 4. They are therefore rejected under the same rationale.

**As per claims 11 and 17:**

The limitations of claims 11 and 17 have already been discussed in the rejection of claim 5. It is therefore rejected under the same rationale.

3. Claims 2, 3, 6, 8,9,12,14,15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,195,627 issued to Bargh and U.S. Patent No. 6,292,909 issued to Hare as applied to claims 1, 4, 5, 7, 10, 11, 13, 16, and 17 above, and further in view of IBM technical Disclosure Bulletin, March 2000, UK (Publication Date: March 1, 2000).

**As per claim 2:**

Bargh and Hare fail to disclose a testcase server. However, IBM technical Disclosure Bulletin discloses a testcase server (Test Server; line 3). It would have been obvious to one of ordinary skill in the art to modify the method of Bargh and Hare to include a testcase server as taught by IBM technical Disclosure Bulletin. The motivation for doing so would have been more convenient to create, distribute and collect harvest event testcases for simulation model.

**As per claims 3:**

IBM technical Disclosure Bulletin discloses the method of claim 1, wherein said comparing said testcase list to said harvest hit table further comprises, responsive to finding a given harvest event within said harvest hit table that does not correspond to a collected testcase within said testcase list, removing said given harvest event from said harvest hit table ("The top section..." lines 13-15).

**As per claim 6:**

IBM technical Disclosure Bulletin discloses a harvest testcase bucket (test buckets; lines 7-8).

**As per claims 8 and 14:**

The limitations of claims 8 and 14 have already been discussed in the rejection of claim 2. They are therefore rejected under the same rationale.

**As per claims 9 and 15:**

The limitations of claims 9 and 15 have already been discussed in the rejection of claim 3. They are therefore rejected under the same rationale.

**As per claims 12 and 18:**

The limitations of claims 12 and 18 have already been discussed in the rejection of claim 6. They are therefore rejected under the same rationale.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. Any inquiring concerning this communication or earlier communication from the examiner should be directed to Kibrom K. Gebresilassie whose telephone number is (571) 272-8571. The examiner can normally be reached on Monday-Friday, 8:30 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Jean R. Homere can be reached at (571) 272-3780. The official fax number: (703) 872-9306. Any inquiring of a general nature relating to the status of this

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application should be directed to the group receptionist whose telephone number is:

(571) 272-3700

  
JEAN P. HOMERE  
PRIMARY EXAMINER